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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/544,799 04/07/00 LEVITAN

J 1026-017/MMM

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MMC2/0712

EXAMINER

SHAFFER, R
ART UNIT PAPER NUMBER

2872
DATE MAILED:

07/12/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/544,799

Applicant(s)

LEVITAN ET AL

Examiner

K.D. SHAYEK

Group Art Unit

2872

— The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address —

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 9 MONTH MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

☒ Responsive to communication(s) filed on 4/7/00

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 1 1; 453 O.G. 213.

Disposition of Claims

☒ Claim(s) 1-38 is/are pending in the application.

Of the above claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☐ Claim(s) _____ is/are rejected.

☐ Claim(s) _____ is/are objected to.

☒ Claim(s) 1-38 are subject to restriction or election requirement

Application Papers

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).

☐ All ☐ Some* ☐ None of the:

☐ Certified copies of the priority documents have been received.

☐ Certified copies of the priority documents have been received in Application No. _____.

☐ Copies of the certified copies of the priority documents have been received

in this national stage application from the International Bureau (PCT Rule 17.2(a))

*Certified copies not received: _____

Attachment(s)

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Reference(s) Cited, PTO-892

☐ Notice of Informal Patent Application, PTO-152

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Other: _____

Office Action Summary

Art Unit: 2872

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 2-4 and 10, drawn to a microelectrical mechanical actuator comprising a substrate having first and second conductors, a first conductive coil, and a magnet with particular coil details, classified in class 310, subclass 328.
 - II. Claims 6-8, drawn to a microelectrical mechanical actuator comprising a substrate having first and second conductors, a first conductive coil, a second conductive coil and a magnet with particular flux and coil details, classified in class 310, subclass 328.
 - III. Claim 9, drawn to a microelectrical mechanical actuator comprising a substrate having first and second conductors, a first conductive coil, a second conductive coil, a magnet and a mirror, classified in class 359, subclass 872.
 - IV. Claims 11-16, drawn to a microelectrical mechanical actuator comprising a substrate, a first conductive coil, a second conductive coil and a magnetic flux means with particular flux and coil details, classified in class 310, subclass 328.
 - V. Claims 17-23, drawn to a mirror actuator device comprising a first and second actuators, each including first and second members, a mirror and a magnetic flux source, classified in class 359, subclass 876.
 - VI. Claims 24-30, drawn to a microelectrical mechanical system comprising a plurality of actuators, each including an electrically conductive coil, a mirror, a magnetic

Art Unit: 2872

flux source, a first current source and a second current source, classified in class 359, subclass 872.-

VII. Claims 31-38, drawn to a microelectrical mechanical actuator comprising a planar substrate, a first magnetic-material member, a moveable device and an electromagnet, classified in class 328, subclass 328.

2. Claim 1 link(s) inventions I, II and III. The restriction requirement between the linked inventions is subject to the nonallowance of the linking claim(s), claim 1. Upon the allowance of the linking claim(s), the restriction requirement as to the linked inventions shall be withdrawn and any claim(s) depending from or otherwise including all the limitations of the allowable linking claim(s) will be entitled to examination in the instant application. Applicant(s) are advised that if any such claim(s) depending from or including all the limitations of the allowable linking claim(s) is/are presented in a continuation or divisional application, the claims of the continuation or divisional application may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application. Where a restriction requirement is withdrawn, the provisions of 35 U.S.C. 121 are no longer applicable. See *In re Ziegler*, 44 F.2d 1211, 1215, 170 USPQ 129, 131-32 (CCPA 1971). See also MPEP § 804.01.

Claim 5 link(s) inventions II and III. The restriction requirement between the linked inventions is subject to the nonallowance of the linking claim(s), claim 5. Upon the allowance of the linking claim(s), the restriction requirement as to the linked inventions shall be withdrawn and any claim(s) depending from or otherwise including all the limitations of the allowable linking

Art Unit: 2872

claim(s) will be entitled to examination in the instant application. Applicant(s) are advised that if any such claim(s) depending from or including all the limitations of the allowable linking claim(s) is/are presented in a continuation or divisional application, the claims of the continuation or divisional application may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application. Where a restriction requirement is withdrawn, the provisions of 35 U.S.C. 121 are no longer applicable. See *In re Ziegler*, 44 F.2d 1211, 1215, 170 USPQ 129, 131-32 (CCPA 1971). See also MPEP § 804.01.

3. The inventions are distinct, each from the other because of the following reasons:

Inventions II and I, III, IV are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because of the omission of a second conductive coil, as evidenced by claim 2; the omission of the particular coil details, as evidenced by claims 5 and 9; or the omission of the substrate having first and second conductors or a mirror, as evidenced by claim 11. The subcombination has separate utility such as a microelectrical mechanical actuator without a second conductive coil, particular coil details or a substrate having first and second conductors.

Inventions VI and V are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the

Art Unit: 2872

particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because of the omission of the actuators having first and second members. The subcombination has separate utility such as ^a microelectrical mechanical system without first and second current sources.

Inventions I, III, IV, V and VII are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, each of the inventions I, III, IV, V and VII have separate utility such as a microelectrical mechanical actuator with the separate details of the other invention(s). For example, the microelectrical mechanical actuator of group III has separate utility as a microelectrical mechanical actuator without the particular coil details of group IV, a plurality of actuators, each having first and second members, of group V or a substrate having first and second conductors of group I...etc.; the microelectrical mechanical actuator of group I has separate utility as microelectrical mechanical actuator without the mirror of group III, the particular flux details of group IV or a plurality of actuators, each having first and second members, of group V...etc.; and ...etc. See MPEP § 806.05(d)

4. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification and/or have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

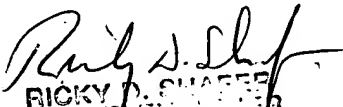
Art Unit: 2872

5. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

6. Any inquiry concerning this communication should be directed to R.D. Shafer at telephone number (703) 308-4813.

RDS

July 10, 2001


RICKY D. SHAFER
PATENT EXAMINER
ART UNIT 2872